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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		<b>Docket Number (Optional)</b>  SCS-124-1116	
Application Number  10/534,494		Filed  May 10, 2005	
First Named Inventor  Lewin			
Art Unit  2878		Examiner  P. Lee	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

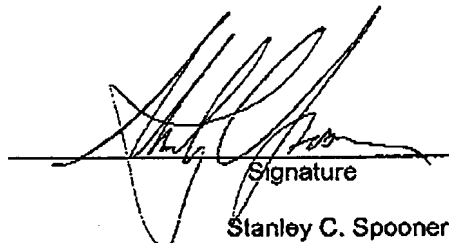
I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

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Registration number if acting under 37 C.F.R. § 1.34 \_\_\_\_\_

  
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Requester's telephone number

June 7, 2007  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.\*

☒ \*Total of 1 form/s are submitted.

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**STATEMENT OF ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Rejection mailed February 7, 2007 (Paper No. 20070201).

**Error #1. The Examiner has failed to comply with the first requirement of examination, i.e., properly construe a means-plus-function claim**

Independent claim 1, from which every other claim depends, recites "an illumination means for illuminating a scene with an array of spots of light." The use of the word "means" is a rebuttable presumption that Applicants intended §112 (6<sup>th</sup> paragraph) format. The absence of structure for providing the claimed functional result further confirms the 6<sup>th</sup> paragraph treatment. Accordingly, the Examiner is obligated to construe the "illumination means" to cover corresponding structure disclosed in Applicants' specification and equivalents thereto.

Alternatively, notwithstanding the use of the term "means" should the Examiner believe the claim provides a sufficient structural definition in the latter portion of the claim (beginning "wherein the illumination means comprises . . .") this must be construed as requiring a structure which illuminates a scene "with an array of spots of light."

In this instance, Applicants' specification discloses a projector system for projecting "an array of spots of light." Applicants' claim also specifies that the illumination means must illuminate a scene with "an array of spots of light." Thus, whether or not construed as a "means" claim, there is no doubt that Applicants' independent claim 1 and all claims dependent thereon must be properly construed to include a structure which illuminates a scene "with an array of spots of light."

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Because the Examiner has not properly construed claim 1 to require the plural "spots of light," his rejection of claims 1-9 and 11-15 under 35 USC §103 over the Immega/Campbell combination is fatally flawed.

**Error #2. The Examiner admits Immega fails to teach the claimed "illumination means" but fails to appreciate that Campbell also fails to disclose any such "illumination means"**

The Examiner's admission that "Immega et al does not explicitly disclose the use of an illumination means with a light source arranged to illuminate the input face of a light guide" is very much appreciated. However, in the first paragraph on page 3 of the Final Official Action, the Examiner alleges that the Campbell reference discloses the claimed "illumination means." The Examiner apparently misunderstands what is disclosed by Campbell.

While the Examiner suggests that illumination source 90 comprises the means for illuminating a scene "with an array of spots of light," Campbell actually confirms that his "preferred illumination source 90 of this invention that provides uniform, intense, parallel illumination of a linear inspection zone." Quite clearly, to those of ordinary skill in the art, Campbell provides "uniform, intense, parallel illumination" of an inspection zone which is the direct opposite of "spots of light." Thus, instead of a plurality of "spots of light," Campbell actually teaches a preferred illumination source which provides a uniform illumination of an inspection zone.

There is no indication that there is any more than one inspection zone and therefore it is impossible for Campbell's structure 90 to be construed to be a projector of "an array of spots of

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light.” In the Examiner’s discussion of the Campbell reference, he does not indicate any structure in Campbell which would project “an array of spots of light.”

Thus, the Examiner admits that Immega fails to teach the claimed structure and, at the same time, fails to point out where the claimed structure is disclosed in the Campbell reference. Because neither reference discloses the claimed subject matter, even if these references were combined, they cannot establish any *prima facie* basis of obviousness under 35 USC §103 for claims 1-9 and 11-15 and any further rejection thereunder is respectfully traversed.

**Error #3. The Examiner fails to provide any “reason” or “motivation” for combining the two references**

As the Court of Appeals for the Federal Circuit has consistently held, it is required that the Examiner identify some “reason” or “motivation” for combining references. This was confirmed recently in a Memorandum dated May 3, 2007 from Deputy Commissioner for Patent Operations Margaret A. Focarino, wherein she stated “in formulating a rejection under 35 USC §103(a) based upon a combination of prior art elements, it remains necessary [for the examiner] to identify the reasons why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.”

Turning to the rejection of claim 1 and the discussion in the first paragraph on page 3 of the Final Rejection, the Examiner alleges that it would be obvious to combine Immega with Campbell “because such would improve the light produced by preventing any shadowing effects.” While Applicants agree that Campbell desires to prevent any shadowing effects because of its “uniform, intense, parallel illumination of a linear inspection zone” (paragraph 0046), this is precisely the reason why Campbell does not teach Applicants’ claimed illumination

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means for illuminating a scene “with an array of spots of light.” Spots of light clearly have darker areas in between the spots and this is the direct opposite of the suggestion the Examiner attributes to the Campbell reference.

Thus, Campbell provides no “reason” or “motivation” for one to combine it with the Immega reference and therefore the rejection under 35 USC §103 of claim 1 and all claims dependent thereon clearly fails.

**Error #4. The Examiner fails to appreciate that Campbell would lead one of ordinary skill in the art away from Applicants’ claimed invention**

The Court of Appeals for the Federal Circuit in *In re Fine* has clearly confirmed that it is clear error if a prior art reference in an obviousness combination “teaches away” from the claimed invention. Here, the claimed invention requires a structure, the illuminating means, for illuminating a scene “with an array of spots of light.”

Campbell specifically teaches that his preferred illumination source 90 illuminates a scene, i.e., the “linear inspection zone” with “uniform, intense, parallel illumination.” (Campbell, paragraph 0046). Thus, if Immega and Campbell were combined, the illumination provided would be “uniform, intense, parallel illumination of a linear inspection zone” which is the direct opposite of “illuminating a scene with an array of spots of light.”

Here the Examiner also admits that Campbell would suggest improving “the light produced by preventing any shadowing effects . . . that would prove to be detrimental to the detected signal.” Thus, the Examiner’s own rejection admits that Campbell would lead one of ordinary skill in the art away from the claimed combination of elements.

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Thus, the fact that Campbell teaches away from the claimed invention is evidence of non-obviousness of the claimed invention.

### SUMMARY

The Examiner admits that Immega fails to teach the claimed "illumination means." The Examiner has failed to indicate that he has properly construed the "illumination means" to require projection of "spots of light" and, in any event, has not demonstrated that the Campbell reference supplies any teaching of "spots of light." As a result, even if Campbell and Immega were combined, there is no disclosure in either reference of any structure for illuminating a scene "with an array of spots of light." Moreover, the Examiner fails to provide any "reason" or "motivation" for combining the references and actually admits a motivation for not combining these references ("preventing any shadowing effects" Final Rejection, page 3, lines 8-9). Finally, the Examiner fails to appreciate that Campbell, in teaching a "uniform, intense, parallel illumination of a linear inspection zone," clearly would lead one of ordinary skill in the art away from Applicants' invention including an "illumination means for illuminating a scene with an array of spots of light."

As a result of the above, there is simply no support for the rejection of Applicants' independent claim 1 or claims dependent thereon under 35 USC §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.